

REMARKS

Reconsideration and allowance of the subject application are respectfully requested by this Amendment, Applicant has canceled claims 11-21 and added claims 22-30. Thus, claims 22-30 are now pending in the application. In response to the Office Action (Paper No. 13), Applicant respectfully submits that the pending claim define patentable subject matter.

In the Office Action, the Examiner maintained the restriction requirement set forth in the Office Action dated July 17, 2002, wherein the Examiner asserts claims 11-21 (added in the Amendment filed May 28, 2002) are directed to an invention that is independent or distinct from the invention originally claimed in claims 2-10 (canceled in the Amendment filed May 28, 2002). In particular, the Examiner has rejected the arguments, set forth in the Request for Reconsideration filed August 19, 2002, regarding the Restriction Requirement being improper because both original claims 2-10 and new claims 11-21 are method claims directed to the same invention.

Although Applicant does not agree with the Examiner's position, Applicant is canceling claims 11-21 and adding canceled claims 2-10 back to the application as new claims 22-30. Applicant submits that claims 22-30 should be allowable since the only claim rejections (as set forth in the Office Action dated February 27, 2002) prior to the cancellation of claims 2-10 were (1) improper double patenting rejections based on parent Application No. 09/624,222 and (2) an improper § 112, second paragraph, rejection wherein the Examiner improperly asserted that product-by-process limitations are *per se* indefinite.

With regards to the double patenting rejections set forth in the Office Action dated February 27, 2002, since the present application is a divisional application under 35 U.S.C. §

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 09/978,548

1.53(b) of U.S. Appln. No. 09/624,222 and was filed due to a restriction requirement therein, 35 U.S.C. § 121 prevents U.S. Appln. No. 09/624,222 from being used as a reference against the present application in a double patenting rejection (see 35 U.S.C. § 121 and MPEP 804.01).

With regards to the § 112, second paragraph, rejection set forth in the Office Action dated February 27, 2002, even if claims 22-30 are construed as product-by-process claims, which Applicant submits is incorrect, it is well settled that a product-by-process claim, which is a product claim that defines the claimed invention in terms of the process by which it is made, is proper. *In re Luck* 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Further, an applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 41 (Bd. App. 1972). See MPEP 2173.05(p).

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 09/978,548

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 09/978,548

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 11-21 are canceled.

Claims 22-30 are added as new claims.